

Instead, the test for determining whether the disclosure complies with the written description of the invention requirement is whether it would have reasonably conveyed to one of ordinary skill that the inventor invented the later-claimed subject matter. In this instance, applicants disclosed that the coating becomes incorporated into the surface of the polyolefin, presumably by fusion (spec. p. 9, lines 30-31). The dictionary sources cited by applicants in the last response affirm that the words found objectionable by the examiner, i.e., “to mix” and “to blend” are substantially identical in meaning and context to the expression “to fuse”. It is, therefore, believed that those words, taken in the context of the claims, are adequately supported by the express disclosure of fusion of the coatings with the polyolefin surface.

Re: The 35 U.S.C. §103 Rejection:

A. The WO 96/23041 Publication is not prior art:

Reconsideration is also respectfully requested of the rejection of the claims under the provisions of 35 U.S.C. §103 as unpatentable over WO 96/23041. As pointed out in the prior response, applicants’ position is that the claimed subject matter is supported in applicants’ prior application, Ser. No. 08/566906 which provides a filing date that antedates the publication of WO 96/23041. Although the examiner has stated that claim 1 of Ser. No. 08/566906 is generic and does not recite polyethylene powder, it should be noted that Example 1 of that application specifically discloses the use of polyethylene powder, thus evidencing that applicants considered the use of polyethylene powder to be a best mode of practice of the invention.

B. The Claims are not obvious from the WO 96/23041 publication:.

Applicants still maintain their position, that the WO 96/23041 publication is not prior art since Ser. No. 08/566906 supports the presently claimed subject matter, however, this request for reconsideration is primarily based on the premise that the claimed use of polyethylene powders in the coating composition used to coat a polyethylene surface is not obvious from the WO 96/23401 publication in

view of the vast superiority of the use of polyethylene powders in the coating composition used in the claimed method for coating polyethylene surfaces.

Those skilled in the art recognize that the term "polyolefin" encompasses a vast number of polymers of widely different properties. Literally, any polymer formed by polymerization of an olefinic monomer, such as polybutene, polyisobutylene, polyvinyl chloride, poly vinyl acetate, poly(ethylene-vinyl acetate), styrene-butadiene rubber, polystyrene, etc., is included in the definition.

While the WO 96/23041 publication might present a *prima facie* case for obviousness, the selection of polyethylene from the huge class of polyolefins is not a routine and obvious matter in view of the unexpectedly superior results which are obtained when compositions containing polyethylene powder are used in the claimed method to coat polyethylene surfaces. Applicants advanced this argument in the previous response, however, the examiner replied that:

...the specification at page 4, lines 19-27 identifies a number of powders that can be used in the claimed invention, and nowhere in the specification is it stated that polyethylene is superior to the other powders named.

Actually, polyethylene powders are disclosed in this application as preferred; see page 4, lines 23-25 where it is stated: "Preferably the thermoplastic powder is at least 50 weight percent polyethylene."

Unexpectedly superior results need not be shown only by an original disclosure, but can be evidenced by a showing of facts in a separate document. Accompanying this response is a declaration by Alan Reeves, a coapplicant and coinventor, which describes comparative experiments performed with a number of polyolefins which demonstrate that the use of coating compositions containing polyethylene powder in the invention to coat the surface of a molded polyethylene article achieves a coating vastly superior to those obtained with other polyolefins in properties of peel resistance and solvent extraction.

In the tests reported in the declaration, the coating on a molded polyethylene surface obtained when using polyethylene powder in the coating composition resisted peeling and solvent extraction. In contrast, the coatings obtained using compositions formulated with other polyolefins, specifically polyisobutylene, polyvinyl chloride, styrene-butadiene rubber, polybutene, poly(ethylene-vinyl acetate) and polystyrene did not exhibit any significant peel and solvent resistance. The declaration concludes with the statement that:

For several years I have worked on formulation of various compositions suitable for use in the invention and I have attempted to use polyolefins other than polyethylene for application to the surfaces of molded polyethylene articles. Only compositions containing polyethylene powders have been found to be universally adaptable to yield coatings which fuse into the surface of a molded polyethylene article and which consistently pass the inspections of peel and solvent resistance described in this declaration.

As pointed out by the Federal Circuit, the discovery that a limited class within a class broadly disclosed by the prior art obtains unexpectedly superior results overcomes the prima facie obviousness of the prior art; see *In re Soni*, 34 USPQ2d 1684, 1687, 1688 (Fed. Cir. 1995) where the court reversed the Board of Appeals which had affirmed the examiner's final rejection of claims to a composition of a conductive filler in an organic polymer of limited molecular weight over prior art showing such a composition with a polymer of a very broad molecular weight range. The applicant had disclosed in the specification that compositions in which the polymer had a limited molecular weight range yielded surprising results. The court stated:

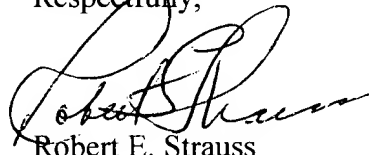
The patent statute provides that "[a] person shall be entitled to a patent unless" any of the Section 102 or 103 bars applies. 35 U.S.C. Section 102. When a chemical composition is claimed, a prima facie case of obviousness under Section 103 may be established by the PTO's citation of a reference to a similar composition, the presumption being that similar

compositions have similar properties. See *In re Dillon*, 919 F.2d 688, 692, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990) (en banc) (structural similarity between claimed and prior art subject matter,... where the prior art gives reason or motivation to make the claimed compositions, creates a prima facie case of obviousness), cert. denied, 500 U.S. 904 (1991). One way for a patent applicant to rebut a prima facie case of obviousness is to make a showing of unexpected results, i.e., to show that the claimed invention exhibits some superior property or advantage that a person of ordinary skill in the relevant art would have found surprising or unexpected. The basic principle behind this rule is straightforward -- that which would have been surprising to a person of ordinary skill in a particular art would not have been obvious. The principle applies most often to the less predictable fields, such as chemistry, where minor changes in a product or process may yield substantially different results.

In summary, applicants have made the requisite showing of surprising or unexpected advantages in the claimed use of polyethylene powder in the coating composition used in the claimed method to coat a molded polyethylene surface. Reconsideration of the final rejection in view of this showing is respectfully requested.

For reasons set forth in this and prior responses, it is submitted that the claims are in proper form and scope and define invention over the prior art. Reconsideration and allowance are respectfully solicited.

Respectfully,

A handwritten signature in black ink, appearing to read "Robert E. Strauss", written over a horizontal line.

Robert E. Strauss
Reg. No. 19,364

October 13, 2003
760-773-0745